



UNITED STATES PATENT AND TRADEMARK OFFICE

7
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,162	03/09/2000	Mark Verdi	MSP-001	2423

21323 7590 03/26/2003

TESTA, HURWITZ & THIBEAULT, LLP
HIGH STREET TOWER
125 HIGH STREET
BOSTON, MA 02110

EXAMINER

HECK, MICHAEL C

ART UNIT	PAPER NUMBER
----------	--------------

3623

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/522,162

Applicant(s)

VERDI ET AL.

Examiner

Michael Heck

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-11 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- ☐ Interview Summary (PTO-413) Paper No(s). _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. The following is a First Office Action in response to the application filed 09 March 2000. Claims 1-11 are pending in this application and have been examined on the merits as discussed below.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Figure 2, item 170. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities:
- a. Page 3, line 3 states, "on-time consulting". It should be --on-line consulting--.
4. The above citation is a mere guide. Applicant is requested to review the specification thoroughly to eliminate additional errors. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3623

6. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 is dependent to claim 1 and limits step (g) by sending the analysis to members of the predetermined group that responded to the first query. The first member that initiated the first message to generate the first query does not receive the analysis unless the first member is a member of the predetermined group and responds to the first query, which means the first person would bias the results of the query. This approach is counterproductive to the intent of the applicant's invention for the first member to receive network consulting. If the first member already knows how to answer the query, then why waste time and money by asking others to validate what is already known.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2, 4, 5, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomas (U.S. Pat Appl. 2002/0002482). Thomas discloses a method and apparatus for performing surveys electronically over a network comprising:

Art Unit: 3623

- [Claim 1] establishing a predetermined group comprising more than two members (Page 2, para 30, Thomas teaches that based on participant categories, participants are selected for the survey);
- receiving at a central location over a wide-area computer network, within a predetermined first time period, a first message from a first member of the group (Page 1, para 14, and Page 2, para 30 and 32, Thomas teaches a survey system coupled to a network where a survey requester places a request for a survey. The network can be a Wide Area Network.);
- defining a first query based on the first message (Page 2, para 30, Thomas teaches a survey is generated when a survey requester places a request for a survey);
- sending the first query from the central location to at least a portion of the predetermined group (Page 2, para 30, Thomas teaches the survey is electronically transmitted to the selected survey participants);
- receiving over the wide-area computer network at the central location, within a predetermined second time period, a message from a second member of the group comprising a response to the first query (Page 2, para 30, Thomas teaches the survey participants complete the survey and have their response electronically returned).
- preparing an analysis at the central location related to the first query and the response to it (Page 2, para 30, Thomas teaches survey results are determined from the response of the participants); and
- sending the analysis over the wide-area computer network from the central location to the predetermined group (Page 1, para 12, and Page 3, para 34, Thomas teaches that optionally, the results are electronically distributed to a survey requestor. The survey requester can be a person or organization and is an option as the predetermined group is an option. If the option was to send or not to send then the purpose of the survey would be a moot point since the requester potentially would not receive the results of the survey, therefore, distribution of the survey results to people other than the survey requester is an option to include the predetermined group.).
- [Claim 2] sending the analysis only to members of the predetermined group that responded to the first query ((Page 1, para 12, Thomas teaches that optionally, the results are electronically distributed to a survey requestor. The survey requester can be a person or organization and is an option as the respondents from a predetermined group is an option. If the option was to send or not to send then the purpose of the survey would be a moot point since the requester potentially would not receive the results of the survey, therefore, distribution of the survey results to people other than the survey requester is an option to include those that responded that were part of the predetermined group.).

- [Claim 4] sending the first query to the predetermined group (Page 2, para 30, Thomas teaches the survey is electronically transmitted to the selected survey participants.);
- [Claim 5] storing the first analysis in the central location such that it is accessible to members of the predetermined group (Page 1, para 14, and Page 3, para 37 and 38, and Page 4, para 53, Thomas teaches a survey/response database for storing responses to the active survey. The database is coupled to the survey manager via a communication link where the survey manager interfaces with the network, selects a group of participants, and takes the survey results and forwards them to the survey requester. The survey archive database stores survey responses for possible future uses. A database including the survey results is e-mailed to the survey requester who then can produce a customized survey report or otherwise make use of the data.);
- [Claim 11] establishing a predetermined group comprising two or more members (Page 2, para 30, Thomas teaches that based on participant categories, participants are selected for the survey);
- receiving at a central location over a wide-area computer network, within a predetermined first time period, a plurality of first messages from members of the predetermined group (Page 1, para 14, and Page 2, para 30 and 32, and Page 3, para 34, Thomas teaches a survey system coupled to a network where a survey requester places a request for a survey. The survey requester can be a person or organization. The network can be a Wide Area Network.);
- generating at least one set of queries based on at least a portion of the first messages (Page 2, para 30, Thomas teaches a survey is generated when a survey requester places a request for a survey);
- sending the at least one set of queries from the central location to the predetermined group (Page 2, para 30, Thomas teaches the survey is electronically transmitted to the selected survey participants);
- receiving at the central location over the wide-area computer network, within a predetermined second time period, a plurality of second messages responsive to at least a portion of the set of queries (Page 2, para 30, Thomas teaches the survey participants complete the survey and have their response electronically returned);
- preparing at least one analysis based on a query in the set and any corresponding responses (Page 2, para 30, Thomas teaches survey results are determined from the response of the participants); and

Art Unit: 3623

- sending the analysis from the central location to the predetermined group (Page 1, para 12, and Page 3, para 34, Thomas teaches that optionally, the results are electronically distributed to a survey requestor. The survey requester can be a person or organization and is an option as the predetermined group is an option. If the option was to send or not to send then the purpose of the survey would be a moot point since the requester potentially would not receive the results of the survey, therefore, distribution of the survey results to people other than the survey requester is an option to include the predetermined group.).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (U.S. Pat Appl. 2002/0002482) in view of Liff (Liff, A., Fostering Online Collaboration and Community, Association Management, Washington, Vol. 50, issue 9, Sep. 1998, Pages 33-38 [PROQUEST]). Thomas discloses a method and apparatus for performing surveys electronically over a network, but fails to teach that members are required to respond to queries.

11. Liff teaches that the community requires participants to interact or be asked not to renew their subscription (Page 38, col. 1, para 3). Liff teaches that it is old and well known in the online collaboration art to require participants to interact. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Thomas with the teachings of Liff to require participants to interact.

Art Unit: 3623

12. The purpose of soliciting an input from a participant is to gain knowledge from the group as a whole. Thomas discloses a system that is more effective, less cumbersome, and faster than conventional processes making the participant more willing to participate (Page 1, para 10). Liff discloses interactive communities where people have an ongoing relationship based on a topic and are linked electronically (Page 34, col. 2, para 3 through to col. 4, para 1). Knowledge management, which is shaping how businesses and organizations will create value in the future, is emerging as a way to manage the intellectual capital of an organization (Page 38, col. 3, para 3-4). The "knowledge network" will accelerate the spread of best practices and best-known methodologies throughout the membership (Page 33, para 1). To facilitate knowledge growth within an organization or group, incorporating Liff's requirement for participants to interact would accelerate the process to create new knowledge, therefore, impacting the companies' bottom line.

13. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (U.S. Pat Appl. 2002/0002482) in view of Harple et al. (U.S. Pat No. 6,195,091). Thomas discloses a method and apparatus for performing surveys electronically over a network, but fails to teach that the member's identity is kept anonymous.

14. Harple et al. teaches a chat tool as part of their collaborative computing system that includes areas for outgoing and incoming messages where the users can elect to have their postings identified or anonymous (Col. 5, line 60 through to Col. 6, line 5). Harple et al. teaches that it is old and well known in the online collaboration art to have the option to be anonymous. It would have been obvious to one of ordinary skill in the art at the time of the applicant's

Art Unit: 3623

invention to modify Thomas with the teachings of Harple et al. to allow the participants to remain anonymous.

15. Thomas' survey system has participants registering electronically if they desire to participate primarily for the purposes of categorizing the participants when selecting participants for the survey (Page 2, para 29). However, depending on the survey subject and method such as a chat tool of Harple et al. the user may want to elect to have their inputs remain anonymous. The purpose of soliciting an input from a participant is to gain knowledge from the group as a whole. Subject matters may be sensitive to the participant, where the participant desires not to be identified. For example, a person may want to explore an ethics question so they know how the group would react to the same situation without divulging who they are for fear of being connected with an ethics violation. An individual participant may have first hand knowledge of the ethical situation in the query and want to share their experience. The predetermined group may elect to maintain the participants anonymity to allow for free and unhindered exchanges of information that otherwise could be detrimental to the participants or the businesses the participants represent, and to communicate acceptable approaches to handle the ethics question.

16. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (U.S. Pat Appl. 2002/0002482), as applied to claim 1.

Claim 3 recites submitting the first query to the first member for approval before sending the first query to the portion of the group. Thomas fails to teach receiving approval prior to sending a query to the group. The examiner takes official notice that it is old and well known in the surveying art to have the requester of the survey review the survey details before authorizing

Art Unit: 3623

it to be distributed to a predefined group. For example, it is common to have a marketing research consulting company generate a survey then review the survey with their client to ensure the survey collects the information that meets the goal of the business requesting the information. In addition, some electronic survey companies have the survey requestor interactively involved in the process of creating the survey, which means the requester is reviewing the survey at the same time it is being generated. In this manner time and resources are reduced and the objectives would be quickly met. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include the approval process to ensure the query meets the objectives of the requestor of the information.

Allowable Subject Matter

17. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- PR Newswire (PR Newswire, ConnectedHealth.Net Provider of Internet-Based Knowledge Management Services to Connect the Health Care Industry, PR Newswire Association, Inc., January 28, 1997 [DIALOG: file 16]) discloses online knowledge sharing where users can pose questions to respected industry authorities on materials

they have reviewed. Users can respond to articles and questions and request additional information or review frequently asked questions for related information. The system can be tailored to allow the user to be connected to only their organization's community.

- Violino (Violino, B., Where CIOs Meet Online, InformationWeek, May 15, 1998 [GOOGLE]) discloses how Chief Information Officers (CIOs) and other high-level IT managers are using "members-only" websites and electronic discussion groups to learn about what their colleagues are thinking and talking about and debate management issues. These communities are considered "knowledge management tools for CIOs".
- Shand (Shand, D., Collaborative Catchball, IntraNet, Network World, Inc., February 23, 1998, [GOOGLE]) discloses collaboration techniques to include experts in a particular field that are tasked to find innovative solutions to a customer problem. Also, a specialist can be assigned to analyze information and distribute findings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Heck whose telephone number is (703) 305-8215. The examiner can normally be reached Monday thru Friday between the hours of 8:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington D.C. 20231

Art Unit: 3623

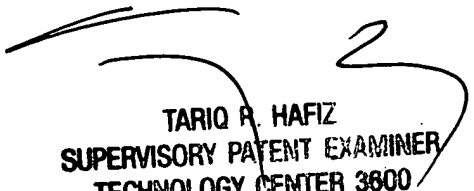
The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular and After Final communications.

The fax phone number for Informal/Draft communication, labeled "PROPOSED" or "DRAFT" is (703) 746-9419.

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, Virginia, 7th floor receptionist.

mch

March 20, 2003



TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600